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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1931.

NOS. 506 AND 507.

AMERICAN TRADING COMPANY,

Petitioner,

vs.

H. E. HEACOCK CO.,

Respondent.

WM. A. ROGERS, LTD., AND AMERICAN TRADING COMPANY,

Petitioners,

vs.

H. E. HEACOCK CO.,

Respondent.

ON WRIT OF CERTIORARI TO THE SUPREME COURT OF THE PHILIPPINE ISLANDS.

BRIEF ON BEHALF OF RESPONDENT.

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ON WRIT OF CERTIORARI TO THE SUPREME COURT OF THE PHILIPPINE ISLANDS.

BRIEF ON BEHALF OF RESPONDENT.

Preliminary.

After hearing the evidence and seeing the witnesses, the Court of First Instance at Manila and on appeal, the Supreme Court of the Philippines without dissent, found as a

fact that Petitioners in their trade in the Philippine Islands were selling tableware bearing marks which falsely represented it to be the tableware long previously dealt in by Respondent. No error in these findings was assigned in Petitioners' appeal from the Court of First Instance to the Supreme Court of the Philippines (Rec. 275) or in the petition for rehearing directed to the Supreme Court of the Philippines (Rec. 303-400) or in their application for certiorari (Rec. 545-551; Petition, 16). In their brief in this court Petitioners do not question the truth of the facts thus found.

The courts below concluded that such conduct amounted in law to trade-mark infringement and unfair competition and enjoined the use of the marking which caused the deception. They also awarded an accounting to compensate Respondent for the injury.

Petitioners' meet the facts with an argument which implies that there is some rule of law which prevents relief against fraud and requires that unfair competition found to exist must be permitted to continue.

Summary of Argument.

Since 1901 Respondent has sold in the Philippines, tableware manufactured in the United States bearing marks the essential feature of which is the word Rogers. Solely as the result of Respondent's distribution and advertising, the word Rogers since 1901, as applied to tableware, became widely and generally known in the Philippine Islands as indicating that the goods bearing it came from Respondent. On June 17, 1918, under the provisions of the Philippine Statute (Act No. 666), which permits the

registration by a dealer of a trade-mark for use in commerce in the Islands, Respondent registered in the Philippine Bureau of Commerce and Industry a trade-mark for tableware which consisted of the word Rogers. The word "Rogers" was registrable under the Philippine Act. Independently of the statutory right, this name had acquired a secondary significance in the Philippines as designating the goods of Respondent.

Twenty-five years after the secondary meaning of the word Rogers had become established, and seven years after Respondent's registration, Petitioner, American Trading Company, for the first time began to sell in the Philippine Islands similar goods stamped with marks of which the word Rogers was the essential and characteristic part. These goods were made by Petitioner, Wm. A. Rogers, Ltd., a Canadian corporation. The result, as found by the courts below, was that, on account of the presence of the word Rogers in the stamp on the tableware sold by Petitioners in the Philippines, the public in the Islands were misled into buying Petitioners' goods in the belief that they were the well-known Rogers ware long previously sold by Respondent.

These facts disclose what this court has said to be the essence of the wrong in both trade-mark infringement and unfair competition cases, namely, the sale of the goods of one manufacturer or trader as those of another. *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. 403, 412.

Unfair competition is a question of fact, to be determined with reference to the particular conditions existing in each case. *International News Service* v. *Associated Press*, 248 U. S. 215, 236; *Reddaway* v. *Banham*, [1896] A. C. 199, 204; *Birmingham Vinegar Brewery Co.* v. *Powell*, [1897]

A. C. 710; *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict,* 198 U. S. 118, 137.

The testimony and findings of the lower courts are conclusive that Petitioners are in fact representing their goods, by the markings upon them, in the Philippines to be goods coming from Respondent. Petitioners are therefore violating the universally accepted principle of law that nobody has any right to represent his goods as the goods of somebody else. *Reddaway* v. *Banham,* [1896] A. C. 199, 204; *American Waltham Watch Company* v. *United States Watch Company,* 173 Mass. 85, 88.

Respondent's Rights arise from two sources: (a) *The Philippine Act No. 666,* which expressly authorizes the registration of a trade-mark by a dealer, and under which in 1918 Respondent registered the word "Rogers". Sections 4, 5 and 7 of the Philippine Act provide a remedy for violation of rights in a registered trade-mark, and also against unfair competition effected by deceptive markings regardless of trade-mark infringement.

The Philippine statute, Act No. 666, was enacted in 1903 by the Philippine Commission under authority of the United States. Since the Philippine Islands are territories of the United States, Congress, under the Constitution, had complete legislative authority over them (*Dorr* v. *United States,* 195 U. S. 138) which was lawfully delegated to the Philippine Commission (*Dorr* v. *United States,* 195 U. S. 138; *United States* v. *Heinszen,* 206 U. S. 370). This general power included the authority to fix the substantive law of trade-marks and unfair competition in the Islands. Philippine Act No. 666 is a comprehensive code of substantive law.

The Federal trade-mark statutes are based on the commerce clause. This court has held that Congress has no authority to legislate upon the substantive law of trade-marks. *Trade-Mark Cases,* 100 U. S. 82; *American Steel Foundries* v. *Robertson,* 269 U. S. 372, 381. The Trade-Mark Act of February 20, 1905 (U. S. C., Tit. 15) is and can be only procedural. There is no conflict between the Act of February 20, 1905 and Phflippine Act No. 666, as they cover different fields.

(b) *Respondent's Rights at Common Law.* Respondent was entitled to be protected against unfair invasion of its long established local good will by Petitioners' use of deceptive marks. *Hanover Star Milling Co.* v. *Metcalf,* 240 U. S. 403, 422.

Whether this case be viewed as one based upon infringement of a trade-mark registered under the Philippine Act, or upon unfair competition as defined by that Act, or upon common law principles, the result reached by the courts below was correct. Petitioners were properly enjoined from their unfair competition.

The Rights Claimed by Petitioners: Petitioner, American Trading Company, asserts that the goods it sold in the Philippine Islands bore marks registered under the United States Trade-mark Act of February 20, 1905, by Petitioner, Wm. A. Rogers, Ltd., and that, since that Act extends to territories under the jurisdiction of the United States, Petitioners assert that this act gives them the right to use the marks in the Philippines. Petitioners proceed upon the theory that registration under the Federal Trade-mark Act is the grant of a right to use the registered mark; but the

exact contrary is the case. *Trade-Mark Cases,* 100 U. S. 82; *United Drug Co.* v. *Rectanus Co.,* 248 U. S. 90, 63 L. Ed. 141, 145.

Petitioners invoke registration under the Federal statute to project an alleged trade-mark in advance of any trade under it, and thus to dislodge a prior occupant of the market from an earned good will. Under the decisions of this Court, this cannot be done. *United Drug Company* v. *Theodore Rectanus Company,* 248 U. S. 90, 95, 63 L. Ed. 141, 146; *United States Printing & Lithograph Co.* v. *Griggs, Cooper & Co.,* 279 U. S. 156.

In effect, Petitioners are asking this court to hold that registration under the Federal Statute is the grant of a right to use the registered marks where the result is deception of the public and appropriation of an established business. *Hanover Star Milling Co.* v. *Metcalf,* 240 U. S. 420.

Petitioner, Wm. A. Rogers, Ltd., Has Divested Itself of the Rights it Claims. The registered marks which Petitioner, Wm. A. Rogers, Ltd., asserts a right to use in the Philippines, were assigned on July 2, 1929, to Oneida Community, Ltd., by an instrument by which Petitioner divested itself of all rights in them in the United States and "its territories, dependencies, and possessions", which includes the Philippines. Any cause of action which Petitioner, Wm. A. Rogers, Ltd., may conceivably have had, has abated and the question as to its rights, if any, is moot. *Mills* v. *Green,* 159 U. S. 651, 653.

The rights of the assignee, Oneida Community, Ltd., are now directly at issue in proceedings between International Silver Company, successor to the original Rogers businesses, and Oneida Community, Ltd., pending in the United States District Court for the Northern District of N[illegible]

Abstract of the Pleadings.

A complaint was filed by Respondent, H. E. Heacock Company, against Petitioner, The American Trading Company, in the Court of First Instance in the City of Manila, on January 12, 1928. The bill alleged that for upwards of twenty years the Heacock Company had been engaged in the importation and sale in the Philippine Islands of flatware with the name "Rogers" stamped on the back of the handle, together with an indication of the material of which the ware was composed; That on or about June 27, 1918, the Heacock Company caused the trade-mark to be registered in its name in the Philippine Bureau of Commerce and Industry consisting of the word Rogers for use on spoons and other flatware, whether nickel, silver-plated, or silver, as well as nickel, silverplated or silver goods of all kinds except cutlery, and ever since the date of registration such trade-mark has been extensively used by the Heacock Company, upon flat ware imported and offered for sale by it throughout the Philippine Islands; that the goods of the Heacock Company, bearing such trade-mark "have become generally, favorably and popularly known in the Philippine Islands as 'Rogers Flat Ware'." The bill alleges that, notwithstanding the ownership of such trade-mark by the Heacock Company, "and of the use made by the Plaintiff thereof as heretofore alleged, and of the favorable reputation the flatware imported by the Plaintiff as 'Rogers Flatware' has come to have throughout the Philippine Islands," the American Trading Company (the sole defendant to the bill) in the

year 1925 or thereabouts, began to import and sell within the Philippine Islands flatware of similar design as that imported and sold by the Heacock Company, with the words "Wm. A. Rogers," together with an indication of the material of which such flatware was composed, stamped in precisely the same position on the back of the handle as the Heacock mark; that American Trading Company, through the use of such mark, has given and is giving said flatware the appearance of the flatware imported and sold by the Plaintiff "in such a way as to induce purchasers to believe that the flatware imported and sold by the Defendant is the same as that imported and sold by the Plaintiff, and such appearance has so induced, and is now inducing purchases in the Philippine Islands in such belief." The bill alleged that the imitation of the Plaintiff's mark upon the flatware imported by the Defendant "has been effected by the Defendant for the purpose of deceiving the public and defrauding the Plaintiff of its legitimate trade, and that the public has been and is being deceived," and Plaintiff "has been and is being defrauded thereby to its great damage" (Rec. 4).

The bill prayed for an accounting of profits and for an injunction enjoining the Defendant from "selling nickel, silver-plated, as well as nickel, silver-plated or silver goods of any kind under any mark where the name Rogers is used, and from any other means by which the public may be induced to believe that the flatware imported and sold by the defendant is the flatware imported and sold by this plaintiff and known as Rogers flatware" (Rec. 5).

To this bill American Trading Company filed an answer (Rec. 6) denying the validity of Plaintiff's registration

alleging that the name "Rogers" is a family name or surname not belonging to the Plaintiff, and stated that all the merchandise imported by the Defendant and sold within the Philippines and bearing the words "Wm. A. Rogers", with other symbols and marks was manufactured by Wm. A. Rogers, Ltd., in the United States of America, and that the trade-marks appearing thereon had been duly registered in the Patent Office in the United States under the provisions of the laws of the United States, and is, therefore, admissible into the Philippine Islands under the provisions of Act 2460 of the Philippine Commission, and the Trade-Mark Acts of the United States. The answer avers that the Defendant, American Trading Company, is acting within the Philippines as the local agent or representative of Wm. A. Rogers, Ltd., a New York corporation,* and that such corporation is engaged in the manufacture of silverware and flatware of various kinds, and that it has registered certain trade-marks in the United States Patent Office which include the word "Rogers", which are listed; that merchandise imported by the Defendant, of which the Plaintiff complains, bears some one or more of such registered trade-marks, and is entitled to admission to the Philippine Islands under Act 2460 of the Philippine Commission as well as the United States Trade-Mark Acts and being entitled to admission into the Philippine Islands through importation from the United States is entitled to be sold therein (Rec. 9).

On January 13, 1928 (Rec. 10), Wm. A. Rogers, Ltd. started suit against H. E. Heacock Company, alleging that

* The complaint was later amended to state the fact that Wm. A. Rogers, Ltd., is a corporation of Canada (Rec. 30).

Wm. A. Rogers, Ltd. is a corporation of the State of New York, and that American Trading Company is a Philippine corporation; that American Trading Company is the Philippine agent or representative of Wm. A. Rogers, Ltd.; that Wm. A. Rogers, Ltd. manufactures in the United States silverplated ware under trade-marks registered in the United States; that American Trading Company, as agent and representative of Wm. A. Rogers, Ltd., has been importing goods bearing some or all of these marks, manufactured by Wm. A. Rogers, Ltd. since 1923. The act complained of is the writing of letters by the Heacock Company to customers of the American Trading Company threatening them with injunction proceedings if they continue the sale of silverware bearing the name "Wm. A. Rogers". The relief prayed was for damages and an injunction against interfering with the importation and sale within the Philippine Islands of silverware manufactured by Wm. A. Rogers, Ltd. and bearing any of the "trademarks set out", the trademarks being those alleged to be registered in the United States Patent Office (Rec. 11). A preliminary injunction was issued against the Respondent on this bill (Rec. 16).

The Heacock Company answered, and filed a cross-complaint against Wm. A. Rogers, Ltd., substantially repeating the averments of its original bill, and asking as against Wm. A. Rogers, Ltd., similar relief as sought against American Trading Company (Rec. 25). Wm. A. Rogers, Ltd. filed a reply to the cross-complaint (Rec. 25).

The Facts as Found by the Courts Below.

The case came on for trial before the Court of First Instance at Manila which found the facts as follows (Rec. 210, 211, 212):

Findings of Fact of the Court of First Instance.

"That H. E. Heacock Co. was organized in the city of Manila in 1909, being the successor to the firm Heacock & Frier which was organized in the same city in 1901, and continued to do business from that time; that from 1901, H. E. Heacock Co., by itself and through its predecessors, imported into the Islands table and silver-plated goods for different uses (Silver-Ware, Flat-Ware & Hollow-Ware) bearing the factory trade-mark 'ROGERS', whereas the American Trading Co. imported goods of the same nature and for the same uses from 1924 or 1925 only; that on June 27, 1918, H. E. Heacock Co. registered in the Bureau of Commerce and Industry the trade-mark 'ROGERS', which was used in the disposal and sale in the Philippines of table and silver-plated goods for different uses, for a period of about twenty years up to the present time (Exhibit 'G'); that the silver-plated goods sold by H. E. Heacock Co., bearing the trade-mark 'ROGERS' have almost the same appearance and design as the goods of the same metal which have been imported and sold by the American Trading Co. (Exhibits 'E' and 'F'); that the silver-plated goods for use in the table and for other purposes manufactured by the International Silver Corporation and imported into the Islands by H. E. Heacock Co. were known generally and in the Islands by their trade-mark 'ROGERS'

and this trade-mark used in connection with said silver-plated goods have been known by the public as goods sold by H. E. Heacock Co.; that the said silver-plated goods with the trade-mark 'ROGERS' were notoriously known in the Philippine Islands due to the extensive propaganda and advertisement made by H. E. Heacock Co. which cost from forty thousand to fifty thousand pesos; that the silver-plated goods for use in the table and for other purposes imported into these Islands by H. E. Heacock Co. and by Wm. A. Rogers Ltd., and the American Trading Co., have the word 'ROGERS' with the addition of other words, figures or symbols indicating the different grades or qualities of the goods; that in the local market the word 'ROGERS' is the one generally known and sought for by the public which desires to buy silver-plated goods for the table and for other purposes, disregarding and over-looking completely the other words, figures and symbols appearing on the goods; that some of the dealers in silver-plated goods imported by Wm. Rogers, Ltd. and the American Trading Co. only make mention and call attention to the word 'ROGERS' appearing thereon, and in almost all cases the public entertained the conviction and the belief, at least, that such silver-plated goods were the same as those which bore the trade-mark "ROGERS" sold by H. E. Heacock Co.; that the American Trading Co., through it and as representative of Wm. A. Rogers Ltd., has succeeded in making a name in the market for the silver-plated goods which it imports and sells in the Philippines, thanks to the word 'ROGERS' engraved thereon, and, finally that H. E. Heacock Co. was informed of the importation of these silver-plated goods bearing the word 'ROGERS' by the American Trading Co. about the end of 1927 only."

Findings of Fact by the Supreme Court of the Philippines.

The Supreme Court of the Philippines said (Rec. 291):

> "The record is conclusive that covering a period of twenty-five years, through extensive advertising and the quality of the wares, the Heacock Company has built up and established a large and extensive business. That its only competitor in that line of goods is the defendant, American Trading Company, which appeared on the scene for the first time in 1925 with wares which are very similar to those imported and sold by the Heacock Company.

And again (Rec. 296):

> "As stated, when Heacock Company first imported such wares into the Philippine Islands it was then a virgin country, and it must be admitted that any business standing or reputation which such wares had up to 1925 were those given to it by the advertising and business methods and dealings of that company."

Rec. 298:

> "It must be conceded that in June, 1918, when Heacock Company applied for, and obtained the registration of, the word 'Rogers', it then had the right to the use of that trade-mark or trade name, for the simple reason that it was the only person then dealing in 'Rogers' wares of any kind, and that Wm. A. Rogers, Ltd. or the American Trading Company did not appear on the scene until seven years later."

Rec. 299:

> "In the final analysis, in June, 1918, Heacock Company duly registered here the word 'Rogers' as its trade-mark. At that time this was a virgin field for the wares evidenced by that trade-mark. Since then, through its advertising, business methods, and dealings, it has built up a growing and increasing market for the sale and purchase of such wares."

Rec. 301:

> "Upon the facts we attach but little, if any importance to the use of the word 'Rogers' as a family name. In any event when Heacock Company applied for the registration of the word 'Rogers' it had the same legal right to the use of that word as Wm. A. Rogers, Ltd., and for seven years it has had the uninterrupted use of that word under that trade-mark, and in the ordinary course of business, stripped of all non-essentials, it must be conceded that in this line of wares, it is the word 'Rogers' which gives the business its intrinsic value, all of which was done by Heacock Company before the appellants ever entered the field."

In speaking of the deceptive effect of the sale of goods marked "Wm. A. Rogers", the Supreme Court said (Rec. 296):

> "It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business, the average public to whom they are sold could not and would not distinguish one from the other."

The courts below thereupon concluded that, as the name "Rogers" in the Philippines had come to mean the goods

dealt in by Respondent, and as Petitioners, long after this identifying meaning had been established, began to sell in the same market goods bearing a mark which was deceptively similar to the mark which Respondent had established, the Petitioners should be enjoined from selling in the Philippine Islands goods bearing such deceptive mark.

The Court directed the issuance of an injunction against Petitioners in the following form (Rec. 543):

> "That they perpetually abstain from importing and selling in the Philippine Islands silver-plated wares for use in the table and for other purposes similar to those imported and sold by the plaintiff, bearing the trademark 'Rogers'" (Rec. 247).

The Testimony Shows Petitioners' Intentional Piracy of Respondent's Established Trade.

Petitioners' scheme is plain from the testimony. Since 1901, "Rogers Silverware" in the Islands had meant goods coming from Heacock (Rec. 36, 37, 50, 54, 55, 63, 70). The testimony of the witness Tupas, a silversmith and jeweler in Manila, is typical (Rec. 70):

> "Q. Do you know the tableware which the firm Heacock is selling and has been selling for some time past?
>
> "A. Yes, sir.
>
> "Q. By what name has that tableware sold by the firm Heacock always been known?
>
> "A. 'Rogers'."

The witness Manual Cuoto, merchandise broker (Rec. 54):

> "Q. According to your knowledge, what meaning, if any, has the word Rogers in connection with plated

tableware in the Philippine market, in the several parts of the Archipelago where you have followed your occupation of merchandise broker?

"A. When one says 'Rogers', it is understood to be from Heacock and it is so sold. A dealer ordering Heacock articles says 'Bring me Heacock articles', because he knows that it is Rogers."

This fact was well known to Petitioners. S. Allen Presby, the president and general manager of the Petitioner, American Trading Company, Philippine agent for Petitioner Wm. A. Rogers, Ltd., when pressed as to his knowledge of the meaning of the word "Rogers" before 1924 and 1925 (Rec. 123) said:

"For your information, I wish to tell you, however, that I then had Rogers silverware on the table in my own home.

"Q. Where did you buy that tableware before 1924 and 1925?

"A. I don't know; my wife probably bought it at Heacock; I don't know."

Then, for the first time in 1925, Petitioner, American Trading Company, imported goods marked "Wm. A. Rogers", and offered them to dealers with the suggestion that they could be sold as "Rogers". There was no advertising of them (Rec. 32, 120) and no attempt to put them on the market as an independent line of merchandise upon their own merits, but on the contrary, they were offered to dealers with the distinct suggestion that they could be sold as and for the only Rogers goods known in the Islands.

Mr. Naftaly, one of the partners in the American Trad-

ing Company, called on Santiago Varela, a merchant in Manila, who testified (Rec. 67):

"Q. And what did Mr. Naftaly tell you on behalf of the firm with reference to this tableware which he was trying to sell you?

"A. He said: 'This is your chance, because you know that the Rogers trade-mark is famous and you can do good business.'"

The obvious suggestion to pass off the unknown product marked "Wm. A. Rogers" as the well known Rogers goods was promptly acted upon. Manual Cuoto (Rec. 54) testified (Rec. 55):

"Q. Have you ever known or has there ever been known in the provinces among the dealers, wholesale or retail, any Rogers tableware other than that sold by the firm Heacock?

"A. Only quite recently it was known that the firm Levy & Blum is selling much cheaper articles.

"Q. When was that?

"A. At the close of 1927.

"Q. And was any Rogers tableware other than Heacock's known in the provinces before that of Levy & Blum?

"A. Before Levy & Blum's, only that of Heacock was known."

Mr. Varela testified (Rec. 63):

"Q. When did you first buy goods or tableware from the American Trading Company?

"A. I recollect that we were the first dealers in Manila who ordered direct through the American Trading Company, because at that time, during the first days we always bought from the firm Heacock;

but as we found an agent who would furnish them at a lower price it was enough for us that it was the mark Rogers and we bought it, because we know that one can do good business with the Rogers ware.

"Q. How did you know before you bought those goods sold by the American Trading Company that you would be able to do good business with the name or mark Rogers?

"A. Yes, sir; because that name is well known in the Philippine Islands; it is known by everybody who is using tableware; they all know what the Rogers ware is.

"Q. If instead of bearing the mark William A. Rogers the tableware of the American Trading Company bore the mark W. Smith, would you have purchased the mark Rogers from the H. E. Heacock Co.?

"A. No, sir, because we know the patterns sold by the firm Heacock and we can find this mark in competition with the firm Heacock."

Mr. Varela further testified (Rec. 69):

"Q. When the buyers came to Bernardo & Varela's establishment while you were connected with that establishment, and now in that establishment of yours, in purchasing tableware, do the buyers pay attention to all the words and all the marks appearing on the tableware, or only to the word Rogers?

"A. As a rule, the majority of the buyers, upon entering, ask for Rogers tableware; of one hundred buyers, barely seven or ten ask for any other make; they ask for nothing but Rogers, always the trade-mark Rogers.

"Q. And do the people make a distinction as to whether it is Rogers Brothers or William A. Rogers, Ltd.?

"A. No, sir, the people only notice 'Rogers'."

The witness Tupas (Rec. 72), referring to the goods marked "Wm. A. Rogers" sold by Petitioner, American Trading Company, testified:

"Q. But, do you know if that is the same Rogers ware that Heacock is selling, or other ware?

"A. Apparently it is the same; only it says Rogers; but I cannot say anything else; I buy it because it is cheap. * * *

"Q. And how did you sell that tableware to the public?

"A. As Rogers ware.

"Q. Did you advise the public whether or not it was Rogers ware of the firm Heacock?

"A. No, sir, because if you say that, they are not going to buy from you but will go direct to Heacock's; they only ask: 'Have you any Rogers tableware?' and I say, 'Yes, I have some here'."

The witness Bernardo (Rec. 83) said:

"Q. What is the principal, if not the only reason, why you decided to order these William A. Rogers, Ltd., sets from the American Trading Company?

"A. Because those of the American Trading Company were marked with the brand Rogers, like Heacock's. * * *

"Q. If those sets offered to you by the American Trading Company had borne any mark or symbol or any combination of words or symbols in which the word Rogers did not appear, would you have ordered any?

"A. No, sir."

The inevitable result, and which was the result no doubt hoped for, occurred. Manuel Cuoto, merchandise broker at Manila, testified (Rec. 56):

"Q. You said that lately your sales of Rogers tableware which bear the word 'Rogers', of Heacock, have decreased. Can you tell the reason why?

"A. Because there were cheaper offers.

"Q. By whom?

"A. By the firm of Levy & Blum." * * *

"Q. And you, as commission salesman of the firm Heacock, were unable to convince the dealers that that tableware sold by the firm Levy & Blum is not the tableware of Heacock?

"A. No, sir, because they do not pay attention to the initials, they pay attention to the word Rogers."

So we have here an unoccupied market in which the word "Rogers" was unknown up to 1901. Then a market from 1901 to 1925 in which Respondent; Heacock, made the word "Rogers" known as indicating goods coming from the Respondent. In 1925 Petitioner, American Trading Company, with full knowledge of the situation and being cognizant that in the Philippine Islands, Rogers as applied to tableware meant tableware coming from Heacock, began the sale of cheap ware marked "Wm. A. Rogers", offering as an inducement to buyers that it could be sold as Rogers and hence as the reputable merchandise coming from Heacock; that dealers in the Philippines sell to their customers goods marked "Wm. A. Rogers" as "Rogers"; that the purchasers in the Islands pay no attention to initials but accept the goods marked "Wm. A. Rogers" as Rogers, not noticing

any difference, and are deceived with the consequence that Respondent's trade is taken away from it, and its business is injured.

The Law Applicable to the Proved Facts.

This situation discloses what this court has said to be the essence of the wrong in both trade mark infringement and unfair competition cases, namely, the sale of the goods of one manufacturer or trader as those of another.

In *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. 403, page 412, Mr. Justice Pitney said:

> "The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another. * * * This essential element is the same in trade mark cases as in cases of unfair competition unaccompanied with trade mark infringement. In fact, the common law of trade marks is but a part of the broader law of unfair competition."

As this court has said on many occasions, unfair competition is a question of fact and is to be determined with reference to the particular conditions which exist in each case.

In the language of Mr. Justice Pitney in *International News Service* v. *Associated Press*, 248 U. S. 215, at page 236:

> "Obviously, the question of what is unfair competition in business must be determined with particular reference to the character and circumstances of the business."

In *Reddaway* v. *Bannam,* 1896 A. C. 199, 204, Lord Halsbury said:

> "My lords, I believe in this case that the question turns upon a question of fact. The question of law is so constantly mixed up with the various questions of fact which arise on an inquiry of the character in which your Lordships have been engaged, that it is sometimes difficult when examining former decisions to disentangle what is decided as fact and what is laid down as a principle of law. For myself, I believe the principle of law may be very plainly stated, and that is, that nobody has any right to represent his goods as the goods of somebody else.
>
> How far the use of particular words, signs or pictures does or does not come up to the proposition which I have enunciated in each particular case must always be a question of evidence and the more simple the phraseology, the more like it is to a mere description of the article sold, the greater becomes the difficulty of proof; but if the proof establishes the fact the legal consequence appears to follow."

And again:

> "What in each case or in each trade will produce the effect intended to be prohibited is a matter which must depend upon the circumstances of each trade, and the peculiarities of each trade. It would be very rash a priori to say how far a thing might or might not be described without being familiar with the technology of the trade.

In *Birmingham Vinegar Brewery Co.* v. *Powell* (1897), A. C. 710, Lord Halsbury said (711):

> "The proposition of law is one which has been accepted by the highest judicial authority and acted upon

for a great number of years. It is that of Turner, *L. J.*, who says in Burgess *v.* Burgess (1853) 3 DeG. M. & G. 204—'No man can have any right to represent his goods as the goods of another person, but in applications of this kind it must be made out that the defendant is selling his own goods as the goods of another.' That is the only question of law which, as it appears to me, can arise in these cases. All the rest are questions of fact. * * * In each case it comes to be a question whether or not there is the statement made; and if the statement is made there can be no doubt of the legal conclusion that he must be restrained from representing that the goods that he makes are the goods of the rival tradesman. Then you get back to the proposition which I have read from Turner, *L. J.*"

This court adopted the view of Lord Justice Turner where in *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict,* 198 U. S. 118, Chief Justice Fuller (p. 137) quoted another portion of his judgment, saying:

> "It is a question of evidence in each case whether there is false representation or not. Burgess *v.* Burgess, 3 De G. M. & G. 896."

So, on the question of evidence, both the testimony and the findings of the lower courts are conclusive that Petitioners by the markings upon them are representing their goods in the Philippines to be those coming from Respondent and Petitioners do not deny it. Therefore, concededly they are violating the principle of law which we had supposed to be universally accepted, that nobody has any right to represent his goods as the goods of somebody else. To

quote Lord Herschell, in *Reddaway* v. *Banham* (1896), A. C. 199, 204:

> "I cannot help saying that if the defendants are entitled to lead purchasers to believe that they are getting the plaintiff's manufacture when they are not, and thus to cheat the plaintiffs of some of their legitimate trade, I should regret to find that the law was powerless to enforce the most elementary principles of commercial morality. I do not think your Lordships are driven to any such conclusion."

There never was a better statement of the general principle that Mr. Justice Holmes' in *American Waltham Watch Company* v. *United States Watch Company*, 173 Mass. Rep. 85-88, where he said:

> "It is true that a man cannot appropriate a geographical name, but neither can he a color, or any part of the English language, or even a proper name to the exclusion of others whose names are like his. Yet a color in connection with a sufficiently complex combination of other things may be recognized as saying so circumstantially that the defendant's goods are the plaintiff's as to pass the injunction line. *New England Awl & Needle Co.* v. *Marlborough Awl & Needle Co.*, 168 Mass. 154, 156. So, although the plaintiff has no copyright on the dictionary or any part of it, he can exclude a defendant from a part of the free field of the English language, even from the mere use of generic words unqualified and unexplained, when they would mislead the plaintiff's customers to another shop. *Reddaway* v. *Banham* (1896) A. C. 199. So the name of a person may become so associated with his goods that one of the same name coming into the business later will not be allowed to use even his own name with-

out distinguishing his wares. *Brinsmead* v. *Brinsmead*, 13 Times L. R. 3. *Reddaway* v. *Banham* (1896) A. C. 199, 210. See *Singer Manuf. Co.* v. *June Manuf. Co.* 163 U. S. 169, 204; *Allegretti Chocolate Cream Co.* v. *Keller*, 85 Fed. Rep. 643. And so, we doubt not, may a geographical name acquire a similar association with a similar effect. *Montgomery* v. *Thompson* (1891) A. C. 217."

"Whatever might have been the doubts some years ago, we think that now it is pretty well settled that the plaintiff merely on the strength of having been first in the field may put later comers to the trouble of taking such reasonable precautions as are commercially practicable to prevent their lawful names and advertisements from deceitfully diverting the plaintiff's custom.

"We cannot go behind the finding that such a deceitful diversion is the effect and intended effect of the marks in question. 'We cannot go behind the finding that it is practicable to distinguish the defendant's watches from those of the plaintiff, and that it ought to be done. The elements of the precise issue before us are the importance of indicating the place of manufacture and the discrediting effect of distinguishing words on the one side, and the importance of preventing the inferences which the public will draw from the defendant's plates as they now are, on the other. It is not possible to weigh them against each other by abstractions or general propositions. The question is specific and concrete. The judge who heard the evidence has answered it, and we cannot say that he was wrong."

Applying to the present case the rule announced in the last paragraph of Mr. Justice Holmes' opinion, the courts in the Philippines, who know local conditions and who heard

the witnesses, granted to the Respondent a measure of relief appropriate to stop the wrong. They thought that Petitioners could not use the word "Rogers" as applied to tableware in the Islands without deceiving the public and injuring Respondent. The question, as Mr. Justice Holmes put it, "is specific and concrete". It deals with a local situation, a local public, and a particular trade.

It appears as a fact stated by the Philippine Supreme Court that in the Philippines, owing to Respondent's long prior use and the acquired reputation there of its goods as Rogers goods, and the later introduction of the tableware marked "Wm. A. Rogers" by Petitioner, American Trading Company:

> "In the ordinary course of business the average public to whom they are sold could not and would not distinguish one from the other" (Rec. 296).

Also, the Philippine Court of First Instance found as a fact that the silverplated goods of Heacock

> "were known generally and in the Islands by their trade-mark 'Rogers' and this trade-mark, used in connection with said silverplated goods, has been known to the public as goods sold by H. E. Heacock Co. * * * and in almost all cases the public entertained the conviction and the belief, at least, that such silverplated goods (those of American Trading Co.) were the same as those which bore the trade-mark 'Rogers' sold by H. E. Heacock Co." (Rec. 210, 211).

In other words, the late comer into that market so used its marks as to cause confusion and deception of the public and injury to an established trader.

The restraint imposed by the Courts below effectively stops an unfair trade practice which ought to have been stopped. It is a mistake to say there are any inflexible rules of law which constrain courts to permit the use of names or marks to be continued when the only result is deception of the public and damage to the trader first in the field.

In *Powell* v. *Birmingham Vinegar Brewery Co.* (1896), 2 Ch. 54, 12 R. P. C. 496, 515, 13 R. P. C. 235, 253, 263, Mr. Justice Stirling said (12 R. P. C. 515):

> "Now, although it has several times been laid down that it is the duty of the person who thus introduces articles of his manufacture into the market under the same name as that employed by another manufacturer to distinguish the goods so newly introduced from those previously in the market, no court has ever said how the distinction is to be made, and, in my judgment, this is not a matter which can be reduced to any simple rule, but must depend on the circumstances of each particular case."

Lord Justice Lindley (13 R. P. C. 253):

> "If it be impossible, profitably, to use the old name, and at the same time so to distinguish the two classes of goods as to prevent the rival goods from being mistaken for others, what is to be done? Is the name to be protected and rivalry prevented, or is the rival to be at liberty to use the name and destroy the trade of the old trader? Both principle and authority clearly appear to be in favor of the old trader if he can prove that the name denotes his goods and that his rivals are, in fact, mistaken for his."

Mr. Sebastian says in his Law of Trade-Marks, Fifth Edition, page 278:

> "In cases in which unregistered trade names, and not registered trade-marks, have been imitated, the usual form of injunction is to prohibit the use of the word 'without clearly distinguishing' the defendant's goods from the plaintiff's. But if the defendant cannot find an effective method of distinguishing, as may often be the case, he must not use the name at all."

Respondent's Rights.

(a) Under the Philippine Act No. 666.

The trade in the Philippines in silverware under the name 'Rogers' was built up by Respondent, and the word 'Rogers' there indicated silverware dealt in by Respondent. Respondent, as a dealer, had a right to register this name as its trade-mark in the Philippines, under the express language of the Philippine statute, Act No. 666 of March 6, 1903. Section 1 is as follows:

> "Section 1. A trade-mark is a name, emblem, sign, or device, employed by any person, firm, or corporation to designate the goods dealt in or manufactured by such person, firm or corporation, for the purpose of enabling the public to recognize such goods and manufactures, and to distinguish them from the goods and manufactures of others."

Section 2 of the Act provides:

> "Section 2. Anyone who produces, or deals in, merchandise of any kind by actual use thereof in trade may appropriate to his exclusive use a trade-mark, not so appropriated by another, to designate the origin or ownership thereof * * * ."

Section 4 is as follows:

"Sec. 4. No action shall be brought for damages for the violation of the rights to use trade-marks defined in the preceding sections nor shall criminal proceedings be entertained as provided in section six of this Act, unless it be first shown that the trade-mark or trade name alleged to have been violated or which gave rise to the criminal action has been duly registered in the Bureau of Commerce and Industry, in accordance with the provisions of this Act."

Section 5 protects trade names, which are defined to be a

"name, device or mark by which is intended to be distinguished from that of others the business, profession, trade, or occupation in which one may be engaged and in which goods are manufactured or sold to the public, work is done for the public, or professional services are rendered to the public."

Section 7 deals with unfair competition, and provides:

"Any person who in selling his goods shall give them the general appearance of goods of another manufacturer or dealer, either in the wrapping of the packages in which they are contained, or the devices or words thereon, or in any other feature of their appearance, which would be likely to influence purchasers to believe that the goods offered are those of a manufacturer or dealer other than the actual manufacturer or dealer * * * shall be guilty of unfair competition * * *"

Section 7 says also:

"This section applies in cases where the deceitful appearance of the goods, misleading as to origin or

ownership, is effected not by means of technical trade marks, emblems, signs, or devices, but by the general appearance of the package containing the goods, or by the devices or words thereon, even though such packages, devices, or words are not by law capable of appropriation as trademarks * * *."

This section applies the remedy for violation of trade-mark rights to unfair competition.

It will be seen that the Philippine statute prohibits an action for damages for infringement of a trade-mark unless the mark has been registered. Further, that the definition of a trade-mark includes a name; that there is no prohibition against the registration of personal names; that a trade-mark may be registered "by any person, firm, or corporation, to designate the goods dealt in", and that anyone who deals in merchandise of any kind may appropriate a trade-mark to designate the origin or ownership thereof; that apart from registration, protection is provided against unfair competition resulting from the imitation of words or any other feature which would be likely to influence purchasers to believe that the goods offered are those of a dealer other than the actual dealer, and it is expressly provided that this section applies in cases where the deceitful appearance is effected, not by means of technical trade-marks, but by words, even though such words are not by law capable of appropriation as trade-marks.

This Act was enacted in 1903 by the Philippine Commission under authority of the United States.

Article 4, Paragraph 3 of the Constitution of the United States is clear in its grant of express power to Congress

"to dispose of and make all needful rules and regulations respecting the territory or other property belonging to the United States". This gave to Congress complete authority to legislate in the Philippines on every subject, including trade-marks and unfair competition. *Dorr* v. *United States,* 195 U. S. 138.

This power of Congress to legislate could be delegated to the Philippine Commission. As Mr. Justice Day said in *Dorr* v. *United States* (p. 153):

> "Further error is assigned in that act No. 277 of the laws of the Philippine Commission was not passed by competent legal authority. The Act was one of the laws of the Philippine Commission, passed by that body by virtue of the authority given the President under the so-called Spooner resolution of March 2, 1901 (31 Stat. at L. 910, Chap. 803). The right of Congress to authorize a temporary government of this character is not open to question at this day. The power has been frequently exercised and is too well settled to require further discussion. *De Lima* v. *Bidwell,* 182 U. S. 1, 196, 45 L. ed. 1041, 1056, 21 Sup. Ct. Rep. 743."

The principle is re-affirmed in *United States* v. *Heinszen,* 206 U. S. 370, where Mr. Justice White said:

> "But the premise upon which this proposition rests presupposes that Congress, in dealing with the Philippine Islands, may not, growing out of the relation of those islands to the United States, delegate legislative authority to such agencies as it may select—a proposition which is not now open for discussion. *Dorr* v. *United States,* 195 U. S. 138, 49 L. ed. 128, 24 Sup. Ct. Rep. 808."

The Philippine Act No. 666 is therefore just as much an act of Congress governing the protection of trade-marks and repressing unfair competition in the Philippines as the national Trade-Mark Act of February 20, 1905, is an act of Congress authorizing the registration of trade-marks used in commerce among the several states, with foreign nations or with Indian tribes. The Philippine Commission, under the authority delegated to it by Congress, had complete power to legislate for the Philippines. It could and did enact a comprehensive code dealing with the substantive law of trade-marks, trade-names, and unfair competition in the sale of merchandise.

The power of Congress to legislate with respect to trade-marks for the United States is based on the commerce clause of the Constitution. The Constitution has given Congress no general authority over this subject (*Trade-Mark Cases,* 100 U. S. 82), and no power to legislate upon the substantive law of trade-marks (*American Steel Foundries* v. *Robertson,* 269 U. S. 372, 381), and under the commerce clause Congress has dealt, not with the substantive law of trade-marks, but with matters of procedure only as in the Act of February 20, 1905 (U. S. C. Tit. 15). There is no national legislation dealing with unfair competition between private traders. Therefore, if there is any conflict between the legislation applicable to the Philippine Islands, under Article 4, Paragraph 3 of the Constitution, which is a grant of general power, and the national legislation with respect to trade-marks under the commerce clause, which is and can be procedural only, the Philippine legislation would seem to take precedence—certainly in matters

involving trade-marks and trade practices within the Islands.

But, as we see this case, whether it be viewed as one based upon infringement of a technical trade-mark registered under the Philippine Act or upon unfair competition as defined by that Act, or upon the common law, the result reached by the courts below was correct. The Philippine statute dealing with unfair competition is a restatement of the common law—that if any person by any means influences purchasers to believe that goods offered by him are those of a manufacturer or dealer other than the actual manufacturer or dealer, the injured party had a remedy by injunction. This is the common law rule, clearly and unmistakably stated in the Philippine Act and this is the rule that the lower courts applied in this case. Indeed, the Court of First Instance (Rec. 247), after quoting Section 7 of the Philippine Act at length, said:

> "From a reading of the foregoing, it may be inferred that H. E. Heacock Co., in this case is entitled to an indemnity from the adverse corporations, not only because the latter violated a registered trademark, but also because they engaged in unlawful competition which was not authorized."

This we submit, was the correct conclusion to be drawn from the language of the Act and facts which this record so clearly establishes.

(b) Respondent's Rights at Common Law.

It must not be forgotten that the rights asserted by Respondent in this proceeding are the rights of *H. E. Heacock Company, and no one else* (Rec. 450). And re-

gardless of registration under the Philippine statute, certainly Respondent was entitled under accepted common law principles, to be protected against the unfair invasion of its local good will by the use of a deceptive mark by Petitioner, The American Trading Company, a local competitor.

In *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. 403, where there was an invasion of an established local trade by the user of a trade-mark who might have a right to use it elsewhere, Mr. Justice Pitney discusses this question at page 420, saying (422):

> "* * * the words 'Tea Rose' in the flour trade in that territory meant flour of the Hanover Company's manufacture and nothing else. * * * But Metcalf's purpose to take advantage of the reputation of the Hanover Company's Tea Rose flour is so manifest, and the tendency of the similarity of the brand and accompanying design, and of the make-up of the packages, to mislead ultimate consumers, is so evident that it seems to us a case of unfair competition is made out. The circumstances strongly indicate a fraudulent intent to palm off the Steeleville Tea Rose flour upon customers as being the same as the Tea Rose flour made by complainant, the reputation of which is shown to be so well established. The mere substitution of 'Steeleville' in the place of 'Hanover' on the labels is not convincing either that the intent is innocent or that the result will be innocuous, since it is accompanied with the words 'Tea Rose' (shown to have acquired a secondary meaning), and with the distinctive wrapping, both indicative in that market of complainant's flour. Complainant is thus shown to be entitled to an injunction against Metcalf, irrespective of its claim to affirmative trade-mark rights in that territory."

The Rights Claimed by Petitioners.

It is asserted that the silver plated ware brought into the Philippines by Petitioner, the American Trading Company was made by the other Petitioner, Wm. A. Rogers, Ltd., a Canadian corporation, and was marked with the name "Wm. A. Rogers" accompanied by other devices, that these marks were registered by Wm. A. Rogers, Ltd. under the United States Trade-Mark Act of February 20, 1905. Petitioners say that this Act, according to its terms, extends to territories under the jurisdiction of the United States, that this includes the Philippine Islands, and therefore it is said that these registrations give to Wm. A. Rogers, Ltd. the right to use the marks in the Philippines and that, as the court below enjoined their use in the Philippines, it denied a right which the Federal statute gives.

This argument, as we see it, loses sight of the nature of a trade-mark right and the effect of registration. Petitioners seem to proceed upon the theory that registration under the Federal Trade-Mark Act gives to the registrant a right of some kind like a patent or copyright—a right in gross; that registration confers an unlimited right to use the registered mark. The exact contrary is the case. As Mr. Justice Miller said in the *Trade-Mark Cases,* 100 U. S. 82:

> "This property and the exclusive right to its use were not created by the Act of Congress, and do not now depend upon that Act for their enforcement. The whole system of trade-mark property and the civil remedies for its protection existed long anterior to the

Act of Congress, and remain in full force since its passage.

These propositions are so well understood as to need no citation of authorities or elaborate argument to prove them."

In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. 141, at page 145, Mr. Justice Pitney said:

"The asserted doctrine is based upon the fundamental error of supposing that a trade-mark right is a right in gross or at large, like a statutory copyright or a patent for an invention, to either of which, in truth, it has little or no analogy.",

The Federal trade-mark statute is a practice act, dealing with procedure only and not with substantive rights in the Philippines or elsewhere. This must be so, for, as Mr. Justice Sutherland said in *American Steel Foundries* v. *Robertson*, 269 U. S. 372, 381:

"that body [Congress] has been given no power to legislate upon the substantive law of trademarks".

Petitioners in this case attempted to sell in the Philippines, silverplate marked "Wm. A. Rogers" twenty-five years after silverplate bearing the name "Rogers" was understood there to mean the goods dealt in by Respondent. Petitioners invoke registration under the Federal statute to project an alleged trade-mark in advance of trade, and thus claim a right to dislodge Respondent, the prior occupant of the market, from its earned good will. This, under the decisions of this Court, cannot be done.

In *United Drug Company* v. *Theodore Rectanus Com-*

pany, 248 U. S. 90, 95, 63 L. Ed. 141, 146, Mr. Justice Pitney said:

"Conceding everything that is claimed in behalf of the petitioner, the entire business conducted by Mrs. Regis and her firm prior to April, 1911, when petitioner acquired it, was confined to the New England states, with inconsiderable sales in New York, New Jersey, Canada, and Nova Scotia. There was nothing in all of this to give her any rights in Kentucky, where the principles of the common law obtain. Hunt *v.* Warnicke, Hardin (Ky.) 61, 62; Lathrop *v.* Commercial Bank, 8 Dana, 114, 121, 33 Am. Dec. 481; Ray *v.* Sweeney, 14 Bush, 1, 9, 29 Am. Rep. 388; Aetna Ins. Co. *v.* Com., 106 Ky. 864, 881, 45 L. R. A. 355, 51 S. W. 624; Nider *v.* Com., 140 Ky. 684, 687, 131 S. W. 1024, Ann. Cas. 1913 E, 1246. We are referred to no decision by the courts of that state, and have found none, that lays down any peculiar doctrine upon the subject of trademark law. There is some meager legislation, but none that affects this case (Ky. Stat. par. 2572c, subsec. 7, pars. 4749-4755). There was nothing to prevent the state of Kentucky (saving, of course, what Congress might do within the range of its authority) from conferring affirmative rights upon Rectanus, exclusive in that commonwealth as against others whose use of the trademark there began at a later time than his; but whether he had such rights, or respondent now has them, is a question not presented by the record; there being no prayer for an injunction to restrain petitioner from using the mark in the competitive field.

It is not contended, nor is there ground for the contention, that registration of the Regis trademark under either the Massachusetts statute or the Act of Congress, or both, had the effect of enlarging the rights of

Mrs. Regis or of petitioner beyond what they would be under the common-law principles. Manifestly, the Massachusetts statute (Acts 1895, p. 519, chap. 462) could have no extraterritorial effect. And the Act of Congress of March 3, 1881 (chap. 138, 21 Stat. at L. 502), applied only to commerce with foreign nations or the Indian tribes, with either of which this case has nothing to do. See Ryder *v.* Holt, 128 U. S. 525, 32 L. Ed. 529, 9 Sup. Ct. Rep. 145. Nor is there any provision making registration equivalent to notice of rights claimed thereunder. The Act of February 20, 1905 (chap. 592, 33 Stat. at L. 724, Comp. Stat. 1916, par. 9485), which took the place of the 1881 Act, while extending protection to trademarks used in interstate commerce, does not enlarge the effect of previous registrations, unless renewed under the provisions of its 12th section, which has not been done in this case; hence we need not consider whether anything in this act would aid the petitioner's case."

The effect of registration under the 1905 Act was later decided by this Court. In *United States Printing & Lithograph Co.* v. *Griggs, Cooper & Co.*, 279 U. S. 156, Mr. Justice Holmes, speaking of the Trade-Mark Act of 1905, said:

"The trial court found the facts to be as above stated and the supreme court held that the 'purpose and effect of the Trade-Mark Act of February 20, 1905, chap. 592, Par. 16, 33 Stat. at L. 728 (U. S. C. title 15, par. 96) was to project the trademark rights of the registrant and owner thereof into all the States even in advance of the establishment of trade therein, and to afford full protection to such registrant and owner.' It affirmed a judgment for the plaintiff giving

the relief prayed and a writ of certiorari was granted by this court.

* * * * * * *

But neither authority nor the plain words of the Act allow a remedy upon it for infringing a trade mark registered under it, within the limits of a state and not affecting the commerce named. More obviously still it does not enlarge common law rights within a state where the mark has not been used. *General Baking Co.* v. *Gorman* (C. C. A. 1st), 3 F. (2d) 891, 894."

In view of these decisions it seems unnecessary to discuss the question to which Petitioners devote so much attention, whether or not the Federal statutes providing for registration of trade-marks extend to the Philippine Islands. It is of no consequence either way. These statutes do not enlarge common law rights.

They certainly do not create trade-marks out of nothing. The Federal trade-mark acts do not confer the exclusive right to use a mark. They record the existence of marks. Registered trade-marks are not grants like patents or copyrights or the grant of arms by a college of heralds. It is fundamental and elementary that trade-mark rights in the United States are common law and not statutory rights. At common law trade-mark rights are inseparable from business. The trade comes first—the trade-mark follows:

Hanover Star Milling Co. v. *Metcalf*, 240 U. S. 403, 414.

"In short, the trademark is treated as merely a protection for the good will, and not the subject of property except in connection with an existing business."

This is merely a corollary of the proposition that under American law trade-marks do not exist apart from a business, *Baglin* v. *Cusenier* Co., 221 U. S. 580, citing with approval *Lecouturier* v. *Rey*, House of Lords (1910), A. C. 265. In this case the French liquidator had procured the transfer on the English register of the trade-marks of the Carthusian monks. Lord Shaw of Dunfermline remarked:

> "The business of chartreuse liqueur as such is carried on by them (the monks) and the English trademarks are therefore trademarks in respect of a thing the business in which is not, and cannot be, conducted by the appellants. The trademarks are in the latter, the business in the monks. My Lords, such severance is not legally possible."

What Petitioners are asserting in this case is the right to separate a trade-mark from a business by invading a territory where previously they had no business and where their goods were unknown, with silverplated ware marked in such a way as to deceive purchasers in that territory into the belief that Petitioners' goods are the well known merchandise bearing the reputable mark of an old established trader.

It is asserted that registration in the Patent Office of the marks by which this fraud is accomplished, confers a right to pirate a valuable business and that the courts are powerless to put a stop to the piracy. Stripped of all pretense, what Petitioners are asking this court to hold is, that registration under the Federal Statute is the grant of a right to use the registered marks to deceive the public and appropriate an established business.

In *Hanover Star Milling Co.* v. *Metcalf*, 240 U. S. 403, 420, this court said:

> "Under the circumstances that are here presented, to permit the Allen & Wheeler Company to use the mark in Alabama, to the exclusion of the Hanover Company, would take the trade and good will of the latter company—built up at much expense and without notice of the former's rights—and confer it upon the former, to the complete perversion of the proper theory of trademark rights."

The Petitioners' argument is based on a similar perversion of the purpose of the Federal trade-mark statutes, which is to protect trade-marks only as a protection to the good will evidenced by them—to prevent and not to promote piracy. To use Mr. Justice Miller's phrase, these statutes are "a judicious aid to the common law" (*Trade Mark Cases*, 100 U. S. 82, 94). The policy of the common law was stated by Mr. Justice Clifford in *McLean* v. *Fleming*, 96 U. S. 245-251:

> "Equity gives relief in such a case upon the ground that one man is not allowed to offer his goods for sale, representing them to be the manufacture of another trader in the same commodity. Suppose the latter has obtained celebrity in his manufacture, he is entitled to all the advantages of that celebrity, whether resulting from the greater demand for his goods or from the higher price the public are willing to give for the article, rather than for the goods of the other manufacturer, whose reputation is not so high as a manufacturer. Where, therefore, a party has been in the habit of stamping his goods with a particular mark or brand, so that the purchasers of his goods having that

mark or brand know them to be of his manufacture, no other manufacturer has a right to adopt the same stamp; because, by doing so, he would be substantially representing the goods to be the manufacture of the person who first adopted the stamp, and so would or might be depriving him of the profit he might make by the sale of the goods which the purchaser intended to buy."

Petitioner, Wm. A. Rogers, Ltd., has Divested Itself of the Rights it Claims.

The petition, which was filed on or about November 6, 1931, alleged (p. 5):

"After the enactment of the Federal Trade-Mark Law of 1905, the petitioner Wm. A. Rogers, Ltd., registered in the United States at different times between 1906 and 1917 (Exhibits 7, 8, 9, 10, and 11, R. 158-184), the following trademarks (R. 11, 282).

WM. A. ROGERS
1881 R ROGERS R
W. R.
WM. A. ROGERS (in Old English script)

and has since used and now owns them."

That this statement of ownership by Petitioner was not inadvertent is shown by its repetition on page 4 of the Petition. The assertion of ownership of registered trade-marks by Wm. A. Rogers, Ltd., is quite at variance with the facts. Petitioner, Wm. A. Rogers, Ltd., now owns no trade-marks, registered or otherwise. The registered

marks referred to at the record pages indicated are No. 54,731 (June 26, 1906), No. 115,395 (February 6, 1917), No. 97,079 (May 17, 1914), No. 68,369 (March 31, 1908), No. 69,548 (June 16, 1908). These were assigned on July 2, 1929, to the Oneida Community, Ltd., by an instrument in writing recorded in the Patent Office on July 9, 1929, in Liber A-140, page 495. A certified copy of this instrument was printed as an appendix to Respondent's brief in answer to the Petition.

The marks which Petitioner Wm. A. Rogers, Ltd. now claims to own, and to be entitled to use are respectively items (s), (n), (m), (i), and (b) in the schedule attached to the assignment by which Petitioner divested itself, three years ago, of all rights in them in the United States and, under the express language of the assignment, "its territories, dependencies, and possessions", which naturally includes the Philippines. Any cause of action which Petitioner, Wm. A. Rogers, Ltd., may conceivably have had has abated and the question as to its rights, if any, is moot under the rule announced by this Court in *Mills v. Green*, 159 U. S. 651, 653.

What rights the Oneida Community, Ltd., the assignee, may have to use the marks claimed by Wm. A. Rogers, Ltd., are directly at issue now in proceedings between the International Silver Company, successor to the original Rogers businesses, and Oneida Community, Ltd., the assignee of Wm. A. Rogers, Ltd., now pending in the District Court of the United States for the Northern District of New York.

There is, therefore, no occasion for this Court to determine the alleged rights of Petitioner, Wm. A. Rogers, Ltd., for two reasons:

(1) The case with respect to the rights asserted by Wm. A. Rogers, Ltd., is moot because that Petitioner divested itself on July 2, 1929 of the rights claimed, and this fact, when not appearing on the record, can be proved extrinsic evidence (*Mills* v. *Green,* 159 U. S. 651, 653).

(2) Any rights which Oneida Community may have are an issue and undetermined in a direct proceeding between it, the assignee of Wm. A. Rogers, Ltd., and the International Silver Company, in a court having jurisdiction of the parties.

Comments on Petitioners' Brief.

The striking characteristic of the Petitioners' brief is that nowhere in it is there a claim that the courts below made any error in their findings of facts. It is not denied that the word Rogers as applied to table ware in the Philippines is understood to refer only to the product of the Respondent, H. E. Heacock Company, and that this had been so for twenty-five years before Petitioners entered the field. It is not denied that Petitioners' goods marked "Wm. A. Rogers" "1881 (R) Rogers (R)" and "W. R." are sold in the Philippines and passed off upon purchasers there as "Rogers goods" and as goods coming from the Respondent. Petitioners do not deny that the unfair competition found against them by both lower courts in fact exists.

Nowhere in the brief is there any argument attempting to justify the acts of the Petitioners in the Philippines as fair trading. It was utterly unfair trading and with the characterization of their conduct as found by both

lower courts, Petitioners do not quarrel; but they say in effect that because of a supposed conflict between the Philippine Trade-Mark Act and the Federal Trade-Mark Act the courts are powerless to grant relief against unfair competition, no matter how flagrant it may be.

The Rights of Wm. A. Rogers, Ltd., and International Silver Co. in the United States are Not Involved in this Case.

There is nothing in the record concerning the history of the business of the International Silver Company, or any facts from which its rights in the United States to the word Rogers can be determined. The record is similarly silent with respect to Wm. A. Rogers, Ltd. The International Silver Company is not a party to this proceeding, and its rights are not involved. Whatever rights Wm. A. Rogers, Ltd., may have had it has assigned.

The rights in the United States of International Silver Company and the assignee of Wm. A. Rogers, Ltd., are not in issue here and are in issue in a pending suit between them. These rights, whatever they may be, need not be, and we think should not be, considered collaterally in this case.

Since, however, Petitioners' brief so insistently and repeatedly asserts that the rights of Wm. A. Rogers, Ltd. (and impliedly of Oneida Community, Ltd., its assignor) have been definitely adjudicated, we consider this question in the appendix to this brief. It is certain that there had been no adjudication which purported to give to Wm. A. Rogers, Ltd. or its predecessor, Wm. A. Rogers, the right or privilege to sell in this country in

the way that sales were conducted by Petitioners in the Philippines. On the contrary, the sale in this country of goods marked "Wm. A. Rogers" in such manner as unnecessarily to confuse the trade would be directly contrary to the decisions, and a general practice of this kind, such as Petitioners intimate is being carried on in this country (brief, p. 12, line 1) would, under the decisions, justify an injunction against any use of the name Rogers by Wm. A. Rogers, Ltd.

The manifest purpose of Wm. A. Rogers, Ltd., the Petitioner here, in its business in this country has been to get some color of right to use the word Rogers on table ware, so that it may be accepted by the public as Rogers table ware and hence as the product of the International Silver Company. Petitioner's brief admits this purpose when it says, at page 12:

> "In this cause Wm. A. Rogers, Ltd. claims only the right to compete for the 'Rogers' business in the Islands on the same basis on which it has competed for it here."

It would be difficult to make a more definite confession of fraudulent intent because the "Rogers business" is certainly not any business established by Wm. A. Rogers, Ltd.

If the goods of the Petitioner sold in the Philippines were sold as "Wm. A. Rogers" and adequately distinguished, there might be some reason for determining whether there is any merit in the assertion so frequently made in Petitioners' brief that the rights of Wm. A. Rogers, Ltd., to use the name "Wm. A. Rogers" had been established by

judicial decisions in the United States; but this is a question which is not before the court. The courts below found, and the fact is, that "Rogers" in the Philippines for twenty-five years has meant goods coming from Respondent. and that goods stamped with marks which include the name Rogers—for example, "Wm. A. Rogers"—sold in the Philippines by Petitioners are sold as "Rogers goods" and are in fact believed by purchasers to be goods coming from Respondent. What the rights of Wm. A. Rogers, Ltd., might be if an honest and successful attempt had been made to distinguish, is a question which this record does not present.

It is stated on page 34 of Petitioners' brief that the registrations of the marks of Wm. A. Rogers, Ltd., in the Patent Office were in effect registration in the Philippine Islands antedating Heacock's registration. This, of course, is but another way of saying that the mere registration of a trade-mark under the Federal Act projects that mark in advance of trade and that the trade-mark exists in places where the goods are unknown. From 1901 onwards, Rogers goods in the Philippine Islands meant goods coming from Heacock. Petitioners suggest that the act of filing a mark in the Patent Office at Washington years afterwards changed the situation in the Philippines and automatically projected the registered mark into the Islands, notwithstanding the fact that until 1925 there were no goods there to bear the mark. This court has intimated that the registration of a trade-mark is not equivalent to notice (*United Drug Co.* v. *Rectanus,* 248 U. S. 90), and that the Heacock Company had no actual knowledge has

been found as a fact in this case. The Supreme Court of the Philippines says (Rec. 298):

> "How could Heacock Company in 1918 know that seven years later the American Trading Company or Wm. A. Rogers, Ltd. would appear on the scene, claiming the right to the use of the word 'Rogers' as a family name? How could it then know that Wm. A. Rogers, Ltd. had registered its trademarks in the United States Patent Office? The construction of this section should be confined and limited to actual matters and things as they existed in 1918 when Heacock Company applied for, and obtained the registration of, the word 'Rogers'."

Petitioners continue to assert that this is really a case between the International Silver Company on the one hand and Wm. A. Rogers, Ltd., on the other, and that the registration by the Heacock Company under the Philippine Act is for the benefit of and indeed by the International Silver Company—forgetting, apparently, the errors assigned.

As to this, we think attention should be called to the fact that after the decision by the Philippine Supreme Court, Petitioners filed an application for rehearing and a motion for new trial, and among the "Errors and Argument in Support Thereof" accompanying the moving papers, stated that it was shown—

> "conclusively that the registration of the alleged trademark was intended for the use and benefit of the applicant (Heacock) and not for the International Silver Co." (Rec. 325).

To this, counsel for Respondent Heacock agreed, stating (Rec. 450):

> "In registering the word 'Rogers' the Heacock Company acted for itself and not as the agent of the International Silver Co. or any other Company."

Thereafter Petitioners assigned as error in this Court (Rec. 548):

> "The finding and holding of the Court that the word 'Rogers' was registered by Appellee (Heacock Company) for the use and benefit of the International Silver Co. * * * is at variance with the pleadings, proofs and theory of appellee and with the judgment of the Trial Court."

This assigned error is stated, along with other alleged errors, as one relied on in this Court (Brief, p. 22); so that this alleged fact, now asserted by Petitioners because it is apparently thought expedient to make an argument based upon it, has been disowned by all parties, including Petitioners. It must, therefore, be accepted that the rights which are being asserted in this cause by us are the rights of Respondent H. E. Heacock Company and no other.

Petitioners' brief presents its argument under seven points.

Under Point I (pp. 25-30) it is argued that there has been such misinterpretation by the Court of the Philippine Act No. 666 as to "interfere with and to burden trade relations between the United States and the Islands."

This argument is really directed not to the merits of the

controversy but to the mere phraseology of the judgment. Respondent's bill (Rec. 5, 25) did not pray for an injunction against importation, but against selling—meaning, of course, local selling within the Philippines. The infringing and unfair acts of Petitioners all had to do with local selling *after the imported goods had "mingled with and become a part of the general property of the" Islands* (*Brown* v. *Maryland,* 12 Wheat. (25 U. S.) 419, 447), cited in Petitioners' brief in connection with its argument on this point (p. 28). The judgment enjoins Petitioners from "importing and selling in the Philippine Islands". If the words "selling in the Philippines" should be construed as comprehensive enough to include selling by Wm. A. Rogers, Ltd. directly to a purchaser in the Philippines, then it might be that the judgment is open to criticism, but, we submit, the words "selling in the Philippines" means local sales—sales of the character of those to which the evidence was exclusively directed, and there is no reason to expect that the Philippine Court would enforce its decree more broadly. When the judgment is thus construed the argument under Point I has no pertinence. It in no way interferes with the importation of goods of Petitioners or the sale of their goods in original packages. The infringement in this case and the unfair competition had only to do with local transactions. The most that can be properly argued is that the judgment is ambiguous in its terms. If it be so it would be enough to reform it to confine its operation to "selling in local trade in the Philippine Islands". But all this is moot. Petitioners have never suggested a desire to sell goods in the Philippines otherwise than in the way that they have done.

Under Point II, it is argued that the Court erred in holding that the United States Trade-mark Act of 1905 does not extend to the Islands, thereby nullifying registrations thereunder, so far as trade relations with the Islands are concerned.

We are not inclined to justify the statement of the Court of First Instance that this 1905 Act is without effect in the Philippines, but this statement was an immaterial one which does not vitiate the conclusion reached by the Court. It was not even adverted to by the Supreme Court of the Islands. The finding is immaterial because the Act of 1905 grants no right to use a mark but only gives certain practice rights to sue infringers of a mark that an owner has registered. The fact of ownership of a registration is not a defense to a suit for infringement of a trade-mark owned by another or to a suit for unfair competition.

Congress enacted the 1905 Trade-Mark Registration Act. It also gave the Philippine Commission the right to enact its local Trade-mark and Unfair Competition Act. Under the Act of 1905 a registrant in the United States who is using his mark for trade with the Philippines can bring suit on his trade-mark registered under that Act against one infringing his trade-marks in trade with the Philippines. Petitioners do not complain that this remedy has been taken away from them. Wm. A. Rogers, Ltd. does not claim that anyone has infringed its marks. On the other hand, the Philippine Act No. 666 is effective to prevent sales within the Philippine Islands which either infringe trade-marks in actual use in the Philippines and registered therein, or which are in the nature of unfair competition. There is nothing inconsistent as between the

remedies provided by the Trademark Act of 1905 and the rights granted by the local Philippine Act 666.

Under Point III Petitioners assert "The Heacock registration is invalid on its face because it is the registration of a personal surname". The Philippine Act includes in its definition of a trade-mark a "name * * * employed by any person, firm or corporation to designate the goods dealt in". This act excepts only names descriptive of the goods and names relating to the geographical place of production. It does not exclude personal names from registration or from the definition of a trade-mark. The Philippine Act differs in this particular from the Federal Act. But even the Federal Act permits the registration of a surname under certain circumstances, as in the so-called ten year proviso, and this court has sustained such a registration and held that the act in this respect conferred definite rights. (*Thaddeus Davids* v. *Davids Manufacturing Co.*, 233 U. S. 461, 471.)

By a parity of reasoning, Respondent's registration of the word "Rogers" under the Philippine Act conferred upon Respondent definite trade-mark rights.

There is no valid reason why Congress, in the exercise of its plenary power over the Philippines, acting through the Philippine Commission, could not do this. In *United Drug Co.* v. *Rectanus Co.*, 248 U. S. 141, this court said:

> "There was nothing to prevent the State of Kentucky (saving, of course, what Congress might do within the range of its authority) from conferring affirmative rights upon Rectanus exclusive in that commonwealth as against others whose use of the trade-mark there began at a later time than his."

Under Point IV Petitioners' brief asserts that Heacock's registration belongs to the International Silver Company and argues that that Company is equitably estopped from claiming exclusive rights in the Rogers name. The fact alleged is not true, nor is there any equitable estoppel as against International Silver Company. We have pointed out (*supra*, p. 48) that the evidence does not justify any finding that the registration does not belong to Respondent Heacock, and that the facts now asserted so positively in Petitioners' brief are exactly opposite to the positive averments of Petitioners' Assignment of Errors. Yet Petitioners' brief asserts that the trademark registered by Respondent under the Philippine Act in reality belongs to the International Silver Company, that it "controls this registration", and that in 1918 it "connived with Heacock to take out this registration".

As to the argument on equitable estoppel, we point out in the appendix that there has not been any equitable estoppel as between International Silver Company and either Wm. A. Rogers, Ltd., or its successor in business, Oneida Community, Ltd., and that all such questions are to be adjudicated in the pending suit between these two manufacturers.

Under Point V it is alleged that the respondents' registration under the Philippine Act is invalid under Section 13 of that Act, because of the earlier Wm. A. Rogers, Ltd., registration in the United States. Obviously the registration referred to in this Section 13 is a registration in the Islands. Petitioners foresee this answer and intimate that it is inconsistent with Section 14, because of the proviso

therein regarding U. S. registrations. There is no inconsistency. On the contrary, the explicit statement in that section that goods carrying marks registered in the United States are, so far only as entry at the Custom House is concerned, exceptions to the general rule, negatives Petitioners' contention that registration in the United States is, of itself, anticipatory.

Under Point VI it is said that the Heacock registration is invalid "because he never applied it to merchandise". The argument is based on the fact that the marks stamped on the goods were those stamped thereon by the manufacturer and included something more than the name "Rogers".

Heacock was the only dealer in this ware in the Philippines. Under the express terms of the Philippine Act (Sec. 2) one "who produces, *or deals in,*" merchandise may register his mark, etc. There is nothing in the Act which requires that the registrant, rather than the manufacturer from whom he purchases, should actually put the mark on the merchandise. It is common knowledge that marks are ordinarily stamped on merchandise during the process of manufacture.

The fact that something else than the single name "Rogers" also appears on the silverware of Heacock is immaterial. The word "Rogers", as shown by the evidence (and as repeatedly found by the Courts as a fact with reference to the use of these marks in this country) is the essential and characteristic part of the marks by which the public identifies the merchandise. The cases cited in Petitioners' brief are not in point, because all relate to cases

where it was found that the alleged infringer had not so simulated the mark as to create confusion.

The Philippine Act defines a trade mark in Sec. 1 and a trade name in Sec. 5.

Under the definitions of these Sections the name "Rogers" was a trade-mark in the Philippines for it was stamped upon the goods and is otherwise a mark within the definition of Section 1 of the Act. It is not necessary to inquire whether it was also a trade name under Section 5. Congress acting through the Philippine Commission had the right to make a surname in exclusive use in the Philippines a trade-mark there. Section 4 provides that registrations shall be the same, whether it be for a "trade mark or trade name", and Section 5 provides that property in trade names "shall be as fully protected as property in a trade mark by the civil remedies provided in Section 3."

Petitioners' argument under "Point VI", beginning page 45, based upon the allegation that Heacock's registration is for a trade-mark, not for a trade name, whereas the word "Rogers" was a name rather than a mark, is clearly without merit. It ignores the explicit definitions of the Act and the identity as between them of the requirements for registration and the remedies provided for infringement.

Under Point VII it is argued that prior use by Heacock is no answer to Petitioners' proposition. It is stated that there is use of two sets of marks which include the word Rogers in this country which "are admittedly not infringements of each other". There is no such admission. The charge of infringement in the pending suit in the Northern

District of New York will settle the question of whether the Oneida Community, Ltd. the assignee of Wm. A. Rogers, Ltd. is an infringer.

There is contemporaneous use by these two concerns of marks which include the word Rogers but there is nothing in this record to show whether or not the use by Wm. A. Rogers, Ltd. was the kind of use carried on by the Petitioners, in the Philippines, the unfair and parasitical nature of which is nowhere denied. If the Court is to accept Petitioners' (Wm. A. Rogers, Ltd.) position that it has full rights in this country to use certain marks, which include the word Rogers, that assumption must include the further one that in this country Wm. A. Rogers Ltd. has so conducted its business as to avoid deceiving the public into buying its goods for the goods of International Silver Company. That assumption cannot be made to apply to the manner in which the Petitioners employed the Wm. A. Rogers mark in the Philippines because the evidence so conclusively shows that the actual use made of this mark in the Philippines was for the sole purpose, and with the sole effect, of inducing the public there to buy the goods which the public supposed came from Heacock. No arguments about the effects of the laws relating to registration of trademarks and no assumptions as to conditions of the trade in this country, can disguise or palliate the fact that in a territory 3,000 miles away, Petitioners started, twenty-five years after the name Rogers was universally understood there as meaning Heacock's goods, to sell their goods merely as Rogers goods in order to take Heacock's trade away from him. It is not a question of a race between the two manu-

facturers to see who would reach the Philippines first as implied in the statement at the foot of page 51 of the Petitioners' brief.

Conclusion.

As we see it, the question in this case is one of fact. The facts have been found by both lower courts, and are conclusively established by the testimony. In the Philippines the name "Rogers" as applied to tableware indicates to the public there that such goods come from Respondent. The business in the Philippine Islands in silverware under the name "Rogers" was established by Respondent and existed for twenty-five years prior to Petitioners' entry into that field. With this trade situation in existence, Petitioners began to sell similar goods in the Philippines marked "Wm. A. Rogers", wth the result that the public in the Islands purchased these goods in the belief that they were the well known "Rogers" goods long previously established in the market by Respondent.

Petitioners do not attempt to meet these facts, but assert that, because Petitioner, Wm. A. Rogers, Ltd., had registered in the United States, trade-marks which include the word "Rogers", Petitioners have a right to sell goods bearing this mark in the Philippines, notwithstanding the established meaning of the word "Rogers" in that territory and notwithstanding the fact that from the markings upon them Petitioners' goods are accepted as Respondent's.

It is argued that no relief can be afforded under these circumstances because of the registration of a trade-mark

in Washington under an act which is not a grant of a right to use, but merely provides remedies against infringement.

There is no collision between the Federal Trade-mark Act and the Philippine statute. They cover different fields. The Philippine Act is a comprehensive code dealing with the substantive law of trade-marks, and is a restatement of the common law. The Federal Act deals with procedure.

The registration by Respondent of the mark "Rogers" is expressly authorized by the Philippine Act, and registration is a condition precedent to the bringing of a suit for infringement in the Philippine courts. It makes no difference whether the word is considered as a trade-mark or a trade name. The Philippine Act includes both. But, regardless of registration, the Philippine Act provides remedies against unfair competition effected by acts such as Petitioners are found to have committed.

The question whether the Federal Trade-mark Act of February 20, 1905 applies to the Philippines is irrelevant. That Act does not purport to and cannot create in the Philippines trade-mark rights any more than it creates them in continental United States.

Petitioners refrained for twenty-five years from any attempt to occupy the Philippine market with goods bearing any of the marks claimed by Wm. A. Rogers, Ltd. By their neglect, Petitioners permitted a local good will to be built up in the Philippines by Respondent through its long continued and exclusive use of the word "Rogers" in that market.

If a conclusion were reached contrary to that arrived at by the lower court, it would necessarily follow that the prior occupant of a well-defined market under a mark which had come to mean his goods would be deprived of an earned good will, and that rights established by twenty-five years of exclusive occupancy would be destroyed.

The lower court, knowing the local conditions in which Petitioners' unfair competition was practiced and being acquainted with the habits and capacity to discriminate possessed by the public in the Philippines, is in the best position to judge the extent of the restraint to be imposed.

We ask that the decree below be affirmed.

Respectfully submitted,

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Counsel for Respondent.

APPENDIX.

The Litigation over the "Rogers" Name.

The long litigation, beginning over sixty years ago, concerning the "Rogers" name for silverplated ware, is known in a general way to every lawyer. The cases attest the regard which the purchasing public has always maintained for the single name "Rogers", notwithstanding the repeated efforts of persons having the family name "Rogers" to trade on that name, sometimes in businesses of their own, and sometimes by lending their names to corporations. Every ingenious device of the unfair trader and every variation of the legal defense based upon the principle that a person has the right to use his own name in his own business are to be found in one or other of the decisions.

The Historical Background of the "Rogers" Name.

The historical background of the "Rogers" name as applied to tableware has been set forth in many of the reported decisions.

R. W. Rogers Co. et al. v. *Wm. Rogers Mfg. Co.*, 70 F. 1017 (U. S. C. C. A. 2nd Circ. 1895):

> "About 40 years ago, three brothers, by the name of Rogers, composed a firm in Connecticut under the style of Rogers Bros. This firm first applied the art of electroplating to the manufacture of silver-plated ware in this country, and acquired by steadfast integrity a

high reputation for the sterling quality of their ware, and the name of Rogers Bros. stamped upon the back of the goods also obtained a widely extended reputation. The complainant, a corporation called the Wm. Rogers Manufacturing Company, is the successor of the business established in 1865 by William Rogers, one of these brothers, and has been since 1872 engaged in manufacturing and selling silver-plated ware, and has continued the trade-marks upon such goods which its predecessor adopted in 1866, viz. '1865, Wm. Rogers Mfg. Co.', and 'Wm. Rogers & Son'. It has also used since 1887 the following mark: (Anchor). Rogers (Anchor). Two other corporations acquired from one or more of these brothers the right to use the name Rogers also, and for a number of years last past the goods of these corporations, called in the speech of the public *Rogers goods,* have maintained a high character and a well-known reputation."

International Silver Co. v. *Simeon L. & George H. Rogers Co. et al.,* 110 Fed. Rep. 955, p. 957, Judge Shipman found:

"In May, 1898, the complainant, called the 'International Silver Company', was formed, which bought or acquired the entire capital stock or properties of 14 silver-plating corporations, including the William Rogers Manufacturing Company, the Meriden Britannia Company, and the Rogers & Bro., and obtained by purchase or assignment the ownership of all their trade-marks, *and now owns and controls* the business of all the original *Rogers companies, with the good-will and trade-marks of each.** The manufacture of the same goods to which their trade-marks were applied is continued by the complainant, the trade-

* Italics ours throughout.

marks are applied, the trade-mark goods are advertised as aforetime, and the exclusive right to the use of these marks is in fact, and is considered to be, of great value. To the goods formerly manufactured by the corporations not entitled to use the Rogers marks the trade-marks are not applied."

These findings as to the original Rogers concerns, the reputation and meaning of the name "Rogers" on silverware and the ownership by International Silver Co. of all the rights therein of the original Rogers concerns has been repeatedly affirmed by the courts and numerous injunctions have been granted against corporations and individuals.

There is No Justification for Petitioners' Claim of Equitable Estoppel.

Petitioners' brief (p. 7) collects the decisions upon which they rely for its contention that Petitioner Wm. A. Rogers Ltd. has adjudicated rights as against International Silver Company to employ in this country the marks it has employed in the Philippines. These decisions do not support any such proposition.

The first is (Wm. A.) *Rogers* v. *Wm. Rogers Mfg. Co.*, 70 Fed. Rep. 1019, C. C. A. 2nd. In that case, which involved a personal defendant claiming the right to use his own name, Judge Shipman, after first setting out that William A. Rogers had in 1894 commenced having very cheap ware manufactured for him stamped with his name, denying a preliminary injunction, found (1020)—

"He [William A. Rogers as an individual] undoubtedly knew that the stamp could and would be used by

dishonest peddlers and dealers in cheap ware to deceive customers, but the affidavits do not afford sufficient basis for a finding that he started in the business and used the stamp for the purpose of making the public believe that his washed-steel Brunswick goods were genuine Rogers goods. There are some indicia of an unworthy purpose to gain an advantage from a name well known to the purchasers of silver-plated ware, but the affidavits do not contain sufficient facts to justify the conclusion that Rogers was using his name unfairly and dishonestly in the business in which he was entitled to use it."

The next case cited is *Wm. Rogers Mfg. Co.* v. *Rogers* (Wm. A.), 84 Fed. Rep. 639, 640. Here Judge Lacombe again refused a preliminary injunction, although finding—

"It is a reasonable inference from all the testimony that defendant expected that unscrupulous dealers would offer his goods as those of one or other of the original manufacturers, *whose name was well known to, and popular with, consumers.*"

However, the Court, in denying the injunction, said that there was—

"not enough to warrant an injunction *so long as defendant's goods are packed and labeled with his own name Wm. A. Rogers, not collocated with other words in such manner as to induce any greater confusion in the minds of purchasers than would naturally be produced by the use of such name.*"

In *Wm. Rogers Mfg. Co.* v. *Rogers* (Wm. A.), 95 Fed. Rep. 1007, C. C. A. 2nd, this decision on preliminary injunction motion was affirmed by a divided Court of two Judges.

A holding on a preliminary injunction that *an individual* will not be enjoined from using only his own name is not an adjudication that the Canadian corporation Wm. A. Rogers, Ltd., later organized by that individual, had the right (1) to continue that name, (2) to inject it into the Philippines twenty-five years after the name "Rogers" was a recognized trade-mark or trade name there, and (3) to use it in the Philippines only in an unfair, parasitical manner. Nor do these decisions evidence any rights of Wm. A. Rogers, Ltd., or its successor Oneida Community Ltd. in this country. If they have such rights, they must be evidenced by some other adjudication, or by facts not in this record.

Other marks asserted on behalf of Wm. A. Rogers, Ltd. (R. 11) are "W. R." andd "1881 (R) Rogers (R) A-1". One of International Silver Company's original marks is "1847 Rogers Bros.," and another is "Wm. Rogers & Son" (Petitioners' brief, p. 10). The use of these "W. R." and "1881" marks of Wm. A. Rogers Ltd. is, to put it mildly, a labeling of the goods in such manner as to induce greater confusion in the minds of purchasers than would naturally be produced by the use of the name Wm. A. Rogers.

Petitioners' brief also refers to four other cases, all of which were decisions in the Patent Office relating to the registration by Wm. A. Rogers, Ltd., of certain specified marks. Decisions of this sort relating to the right to register marks under the Statutes resulting merely in *prima facie* evidence of ownership, are not *res adjudicata* on the question of the right to use the trade-marks.

The first of the cited cases is *Wm. A. Rogers, Ltd.*,

International Silver Co., 30 App. D. C. 97, which was heard on a demurrer to an opposition to the application of Wm. A. Rogers, Ltd., to register the name "Wm. A. Rogers". The Commissioner of Patents had held that the finding in (*Wm. A.*) *Rogers* v. *Wm. Rogers Mfg. Co.*, 70 Fed. Rep. 1019, *supra*, that Wm. A. Rogers would not be enjoined from using his own personal name, did not justify the registration of such name as a trade-mark. (*International Silver Company* vs. *Wm. A. Rogers, Ltd.*, 1907 C. D. 631, 637.) This, we submit, was a correct finding. The Court of Appeals for the District of Columbia, however, reversed this decision, saying (30 App. D. C. 97, 105)—

> "The opposer did not show any right to use the mark or name, 'Wm. A. Rogers,' but only those of 'Wm. Rogers Mfg. Co.' and 'Wm. Rogers and Son'. In view of what has been heretofore said, it is unnecessary to consider whether, if these were all technical trade-marks, the applicant's mark so closely resembles the others as to constitute an infringement. Each party is entitled to use his own name, actually or legally acquired, without regard to the confusion that may result from similarity."

We question the correctness of this finding, and believe it to be inconsistent with the principles of trade-mark law established by this Court. However, the Court itself recognized that the merits of the controversy were not adjudicated, saying—

> "No right of property will be concluded by the registration of appellant's mark. All parties affected are free to maintain whatever rights they may have in law or equity in the courts having jurisdiction therein."

The two next decisions cited by petitioners are those of *Wm. A. Rogers, Ltd.* v. *International Silver Co.*, 34 App. D. C. 410 and 413. These were opposition proceedings relating to specific marks sought to be registered by Wm. A. Rogers, Ltd. It is enough to say as to these cases that they relate to marks quite different from any of the marks used in the Philippines by petitioners.

The last of these decisions in the Court of Appeals for the District of Columbia is *Wm. A. Rogers, Ltd.*, v. *International Silver Co.*, 34 App. D. C. 413. In that case—

> "The mark of appellant [Wm. A. Rogers, Limited], here involved is 'Rogers' preceded by a wreath inclosing the letter 'R', and followed by the same combination with the numeral '1881'."

The Court sustained the opposition because the mark was confusingly similar to International Silver Company's old mark of "Rogers" preceded and followed by an anchor. Incidentally the Court observed—

> "Appellant's reason for adopting this mark, as disclosed by the testimony, is not above suspicion."

In the same case the Court said (pp. 485, 486):

> "When this mark was adopted by appellant [Wm. A. Rogers, Ltd.], appellee [the International Silver Co.], had long used the mark 'Rogers' preceded and followed by an anchor, and this appellant knew * * *. As applied to silverware, they are greatly reduced in size."

One of the marks used in the Philippines was the mark "1881 (R) Rogers (R)", the (R) meaning the letter R

enclosed in a wreath (petitioner's brief, p. 6). This mark is substantially the same as the mark which the Court of Appeals for the District of Columbia refused to permit to be registered. It merely locates differently the numerals "1881".

The same finding as to the long use by International Silver of the mark "Rogers" with nothing more than an anchor symbol preceding and succeeding the name was made in *International Silver Co.* v. *Simeon L. & George H. Rogers Co. et al.*, 110 Fed. Rep. 955, 957. The Court there stated:

> "It also used, from and after 1877, the following mark [figure of anchor] ROGERS [figure of anchor]" (p. 957).
>
> "* * * The William Rogers Manufacturing Company and its successor [International Silver Co.] have continuously used '[anchor] ROGERS [anchor]'" (p. 958).

Defendant in that case, among other infringing marks had used the mark consisting of [Maltese cross] ROGERS [Maltese cross]. The Court also said (p. 958):

> "The monograms of the defendant, when reduced to the size necessary for stamping them upon the back of the spoon or fork, *are too small* to be easily decipherable by a person with no previous knowledge of their meaning. Such a person simply understands that they represent something, and consequently *the name 'Rogers'* or 'Rogers Bros.' is both the prominent and *the legible imprint upon the article.*"

Also says the Court (p. 959):

> "Neither can the defendant corporation simulate the marks of the complainant by the use of the *name* 'Rogers Bros.' or 'Rogers' with or *without* a preceding or succeeding emblem or symbol or initials. These names are the substantial and distinctive part of the trademark in the mind of the purchasing public."

It is clear that, so far as International Silver Co. is concerned, it has the adjudicated right to the use of a trademark which for all practical purposes to the mind of the public consisted of the word Rogers alone. It is immaterial in this connection whether or not some other concern had a personal privilege to the use of a mark in which, as a part thereof, the word Rogers was used. Such a concern certainly could not use a mark amounting substantially and practically to Rogers alone. International Silver Co. could and did.

So much for Petitioners' assertion that the rights of Wm. A. Rogers, Ltd., in these various marks had been adjudicated. One of the three marks was held registerable in the Patent Office because it was treated as the name of the concern. Another, "1881 (R) Rogers (R)", was used in direct violation of the ruling of the Court on a substantially identical mark. The third, "W. R.", has never been before the Courts. Its use is obviously inexcusable. Wm. A. Rogers only differs from the Wm. Rogers of International Silver Company marks (being the original Wm. Rogers from whom they were derived), by the middle initial "A". Even this small differentiation is omitted from the "W. R." mark. The purpose could only be to deceive and trade unfairly.

On page 11 of Petitioners' brief the case of *Wm. A. Rogers, Ltd.*, v. *Rogers Silverware Redemption Bureau*, 247 Fed. Rep. 178, is quoted as an instance of a discussion of the right of the parties to the use of these marks in interstate commerce. This was a case in which International Silver Company was not involved, and had to do with a contract between Wm. A. Rogers, Ltd., and the defendant there. The *obiter dictum* of Judge Manton as to the limitation of the rights of International Silver Company is of no force, and is not supported by the decision in the Court of Appeals for the District of Columbia, from which he quotes.

Decisions Enjoining Improper Use of the Name Rogers.

Wm. A. Rogers Mfg. Co. v. *Rogers & Spurr Mfg. Co.*, 11 F. 495 (1882), U. S. Circuit Court, Mass., at page 499:

> "* * * The reputation which the goods * * * have now acquired depends upon the conduct of those who now use those names, not upon any supposition in the minds of the purchasers that the persons who originated the business still conduct it."

Also at page 499:

> "A great deal was said in argument about the natural right of a man to use his own name in any business that he chooses to adopt. This, however, as I have said, is the case of the defendant corporation which has adopted a name to suit its business; and of persons having the name who have adopted a trade-mark to let out for hire to other people."

And at page 500:

> "The Rogers name does not express a certain sort of goods but serves as a warranty of good workmanship because all those persons who have used it have followed faithfully the excellent example of the original Rogerses, who insisted on honest work."

Some of the organizers of the defendant in that case had the family name of Rogers. The Court found for the plaintiff in accordance with its prayer for—

> "an injunction against the use of the trade-marks set out in the bill, or any other stamp having the word 'Rogers' or 'Rogers & Son' as the whole or part thereof upon silver-plated forks, knives and spoons."

In *William Rogers Mfg. Co.* v. *R. W. Rogers Co.*, 66 Fed. Rep. 56, 57, Judge Lacombe granted a preliminary injunction, saying—

> "Although the use of a personal name as a trade-mark will not be protected against its use in good faith by a defendant who has the same name, the reason of the rule ceases, and the rule no longer applies, where the defendant, as in the case of a corporation, selects its own name; especially where it appears that such name is selected with an intention to mislead. The affidavits leave little doubt in my mind that the incorporators of defendant selected for it the name 'R. W. Rogers Co.', not because the reputation of its stockholder R. W. Rogers was such that the use of his individual name would increase the chances of business success on its own merits, but because it would give a title so similar to the name in the original trade-mark that purchasers might be induced to buy defendant's goods in the belief that they were complainant's."

On appeal, *R. W. Rogers Co. et al.* v. *Wm. Rogers Mfg. Co.*, 70 Fed. Rep. 1017, 1019, this finding was affirmed in an opinion of Judge Shipman, while Judge Wallace, concurring, said—

> "I place my concurrence in the judgment in this cause upon the broad ground that a body of associates who organize a corporation for manufacturing and selling a particular product are not lawfully entitled to employ as their corporate name in that business the name of one of their number when it appears that such name has been intentionally selected in order to compete with an established concern of the same name, engaged in similar business, and divert the latter's trade to themselves by confusing the identity of the products of both, and leading purchasers to buy those of one for those of the other."

In *William Rogers Manufacturing Company* v. *The Rogers Manufacturing Company*, 16 Philadelphia 178, 185, the Court found that the defendant corporation had been organized by a lawyer by the name of George Rogers, that that name was selected—

> "for the purpose of gaining an advantage over the persons who are legally entitled to it"

and, therefore, that the defendant should be enjoined

> "from the use of the word Rogers upon silver-plated ware, as prayed for in the bill."

In *International Silver Co.* v. *Simeon L. and George H. Rogers Co. et al.*, 110 F. 955, 957, U. S. Circuit Court

Conn. 1901, the Court found that International Silver Company—

> "now owns and controls the business of all the *original* Rogers companies, with the good-will and trademarks of each."

And further, at page 959—

> "Neither can the defendant corporation simulate the marks of the complainant by the use of the name 'Rogers Bros.' or '*Rogers*', with or without a preceding and succeeding emblem or symbol or initials. These names are the substantial and distinctive part of the trademark *in the mind of the purchasing public* * * * and the simulation is sufficiently complete when 'Rogers Bros.' or '*Rogers*' is plainly presented, *either alone* or accompanied by some symbol or emblem or hieroglyphical device."

A preliminary injunction was ordered accordingly, the Court stating that:

> "The name of the corporation was selected solely for the benefit which would accrue from the name 'Rogers' * * *."

The Court did not grant an injunction against the use of the full corporate name at that time, although the Court stated that—

> "The history of the corporation would strongly tend to the conclusion that its name had been selected unnecessarily for the purpose of unfair competition."

The Court preferred to await granting of an injunction against any use of the full corporate name to final hearing.

In *International Silver Co.* v. *Wm. G. Rogers Co. et al.*, 113 Fed. Rep. 526, 529, Judge Colt found as follows:

> "From this statement of facts and circumstances, the inference, to my mind, is irresistible that the defendants have adopted the corporate name 'Wm. G. Rogers Company' and have placed the mark 'Wm. G. Rogers' upon the plated silverware manufactured and sold by the defendant company for the purpose of deceiving the public, and in order to compete in an unfair and illegal manner with the Wm. Rogers Manufacturing Company, of which the complainant is the successor. Following the rule laid down by Judge Shipman in the recent case of International Silver Co. *v.* Simeon L. & George H. Rogers Co. (C. C.) 110 Fed. 955,—a very similar case, involving the same trade-mark,—I will not, on motion for preliminary injunction, enjoin the corporation from any use of its corporate name, but an injunction may issue restraining the defendants from making, marking, selling, or in any manner disposing of silver-plated ware stamped with the mark 'Wm. G. Rogers', or any other mark of which the words 'Wm. Rogers' are a characteristic part."

Among the defendants thus enjoined was Wm. G. Rogers personally.

On appeal *Wm. G. Rogers Co. et al.* v. *International Silver Co.*, 118 Fed. Rep. 133, the injunction order against both the corporation and the individual was affirmed, Judge Putnam in his decision saying that it was established by the record—

> "beyond any reasonable doubt that the purpose of Rogers, from the incipiency of the business, was as stated in the complainant's bill, and was not *bona fide*."

International Silver Co. v. *Rodgers Brothers Cutlery Co. et al.*, 136 F. 1019, U. S. Circuit Court, W. D. Michigan, 1905.

> "* * * the goods manufactured by the complainant have come to be known as *'Rogers goods'* and 'Rogers Bros. goods'."
>
> "They [defendants], however, chose a trademark which already had a value and the property in which was in the complainant for *the word 'Rogers'* connected with cutlery and tableware has come to have a secondary significance which is entitled to protection."
>
> "This is not the case of a man using his surname in a business open to him and the claimant's cases upholding such a right do not apply, but the controversy here is ruled by principles laid down in such cases * * * where corporations have many times been enjoined from the use of a name taken from that of its stockholder or officer."

The Court directed a preliminary injunction which seems to have included the enjoining of the use of the corporate name in this silverware business.

In *International Silver Co.* v. *Wm. H. Rogers Corp.*, 67 N. J. Eq. 646, 647, the New Jersey Court of Errors and Appeals ordered an injunction against the defendant corporation from any use of the name "Rogers" even as a part of its corporate name, saying—

> "The facts stated in the vice-chancellor's opinion, and sustained by the evidence, demonstrate, in our judgment, that William H. Rogers had engaged in the business of selling silver-plated ware as far as

he can be said to have engaged in that business at all, in view of his other vocations, solely with the object of profiting *by the similarity of his name to the name of Rogers, so well known in the trade, to the good will of which the plaintiff had succeeded.*"

Also:

"The defendant was under no compulsion to use the name Rogers at all and if the name had not been used confusion would have been impossible."

In the later case of *International Silver Co.* v. *Wm. H. Rogers,* 72 N. J. Eq. 933, the same Court dealt with a business carried on thereafter by Wm. H. Rogers personally, who marked his goods "W. H. Rogers, of Plainfield, N. J.", and placed on the packages "Not connected with any other Rogers". The Court said—

At page 936:

"While a personal name may not constitute a technical trademark, yet where an article has come to be known by that personal name, one may not use that name, even though it be his own, to palm off his goods as the goods of another who has first adopted it, and by which appellation the goods have come to be known, when the use of his own name for such purpose works a fraud. * * *"

Also at 937:

"*It is the word 'Rogers' that is all controlling,* and it is that which should be differentiated in order to effectually distinguish the goods. * * *"

And at page 938:

> "The defendant having failed in the performance of his duty so to distinguish his silverware that it could not be mistaken for that of the complainant, we think the complainant is entitled to have an injunction restraining the defendant from manufacturing and selling his goods unless he stamps upon them the words, 'Not the original Rogers' or 'Not connected with the original Rogers'".

Thus it has been repeatedly decided by the Federal Courts and various State Courts that the purchasing public in this country has for generations recognized the single name "Rogers" as the identification of the silverplated ware of International Silver Company and its predecessors; that that name has acquired such secondary significance as to have the practical effect of a technical trade-mark, subject only to the personal privilege of a person bearing the surname Rogers in good faith to use his own name but with the obligation of distinguishing his goods from those of International Silver Company. Nothing in these decisions or this record affords any justification for such practices in this country as Petitioners aver that Wm. A. Rogers, Ltd., employed, or for the employing of such practices by any successor in business of Wm. A. Rogers, Ltd. If there be any such justification, Oneida Community, Ltd., can advance it in the pending suit brought against it by International Silver Company. There is no ground for first tacitly assuming that Wm. A. Rogers, Ltd. had the right to trade unfairly with International Silver Co. in this country and then using that assumption as a reason for justifying Peti-

tioners in initiating in the Philippines, after twenty-five years of exclusive use by Respondent of the name "Rogers" on silverplated ware a competition so deliberately deceptive that Petitioners' brief makes no attempt to justify it as fair competition.